

## **REMARKS**

Claims 37-74 are pending in this application. New claims 75-80 have been added to more particularly point out and distinctly claim that which Applicants regard as the invention. Support for new claims 75-80 can be found in the specification at, e.g., page 13, lines 11-34; page 14, lines 4-31; page 41, line 29 to page 42, line 14; page 44, lines 2-9; page 52, lines 21-23; and page 53, lines 13-19. As such, no new matter has been added.

## **RESPONSE TO RESTRICTION REQUIREMENT**

The Examiner has required an election under 35 U.S.C. § 121 and § 372 of one of the following groups:

- Group I**      Claims 37-40, 60 and 65, drawn to an Smurf polypeptide (SEQ ID NO:2), classified in class 530, subclass 350.
- Group II**     Claims 41-44, drawn to an Smurf polypeptide (SEQ ID NO:4), classified in class 530, subclass 350.
- Group III**    Claims 45-50 and 57-58, drawn to a nucleic acid (SEQ ID NO:1), classified in class 536, subclass 23.1.
- Group IV**     Claims 51-56, 59-60 and 62, drawn to a nucleic acid (SEQ ID NO:3), classified in class 536, subclass 23.1.
- Group V**      Claims 63-64, drawn to a transgenic non-human animal, classified in class 800, subclass 8+.
- Group VI**     Claim 66, drawn to a method for promoting a bone morphogenic protein or tumor factor-beta activation pathway (SEQ ID NO:2), classified in class 435, subclass 6.
- Group VII**    Claim 68, drawn to a method for promoting a bone morphogenic protein or tumor growth factor-beta activation pathway (SEQ ID NO:4), classified in class 435, subclass 6.
- Group VIII**   Claim 67, drawn to a method for inhibiting a bone morphogenic protein, classified in class 536, subclass 24.5.
- Group IX**     Claims 69-72, drawn to a method of screening for a modulator of Smurf activity, classified in class 435, subclass 7.1.
- Group X**      Claim 73, drawn to an antibody that binds the amino acid in (SEQ ID NO:2), classified in class 530, subclass 387.1.
- Group XI**    Claim 74, drawn to an antibody that binds the amino acid in (SEQ ID NO:4), classified in class 530, subclass 387.1.

The Examiner contends that the inventions of Groups I (claims 37-40, 60 and 65), II (claims 41-44) and IX (claims 69-72 and new claims 75-80) are distinct from each other. Applicants respectfully traverse the Restriction Requirement and request a modification of the requirement so that Groups I, II and IX be combined and examined together in the instant application. The claims of Groups I, II and IX each relate to Smurf polypeptides. Group I relates to Smurfs comprising the amino acid sequence of SEQ ID NO:2 and Smurfs having greater than a specified homology to SEQ ID NO:4. Group II relates to Smurfs comprising the amino acid sequence of SEQ ID NO:4 and Smurfs having greater than a specified homology to SEQ ID NO:4. The screening method claims of Group IX apply to all Smurf polypeptides including the Smurf polypeptides of Groups I and II. A search for the subject matter of Group IX should uncover any relevant art pertaining to the Smurf polypeptides of Group I and II. Thus, Applicants assert that to search and examine the claims of Groups I, II and IX would not be a serious burden on the Examiner. The M.P.E.P. § 803 (Eighth Edition, Rev. 1, Feb. 2003) states:

If the search and examination of an application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, in view of M.P.E.P. § 803, all of the claims of Groups I, II and IX should be searched and examined in the subject application. Accordingly, Applicants respectfully request that the Restriction Requirement Under 35 U.S.C. § 121 be modified such that the subject matter of Groups I (claims 37-40, 60 and 65), II (claims 41-44) and IX (claims 69-72, new claims 75-80) be examined in one application.

In order to be fully responsive, however, Applicants hereby elect to prosecute the claims of Group IX, claims 69-72 and new claims 75-80, drawn to methods of inhibiting ubiquitination of SMADs, with traverse, without prejudice to Applicants' right to pursue the non-elected subject matter in related applications.

Applicants note that in the Office Action, mailed March 1, 2004, the Examiner has mistakenly taken the position that SEQ ID NO:2 and homologous sequences as claimed in the instant application are taught by Beach (WO 97/12962). However, a close inspection of SEQ ID NO:2 and the sequences described in Beach reveals that this is not the case.

Entry of the remarks made herein is respectfully requested. The Examiner is invited to contact the undersigned with any questions concerning the foregoing.

Respectfully submitted,

Date: July 1, 2004

Anthony M. Insogna 35,203  
Anthony M. Insogna (Reg. No.)  
**JONES DAY**  
222 East 41<sup>st</sup> Street  
New York, New York 10017  
(212) 326-3939

by Eleon Faleg 46,097  
(Reg No)